

REMARKS

Claims 1 and 7 have been canceled. Claims 2-6, 8-14 and 17-21 have been amended. No new matter has been added. Claims 2-6, 8-14 and 17-21 are pending.

35 U.S.C. § 103 Claim Rejections

Claims 1-14 and 17-21 stand rejected as being unpatentable over Kroll et al. (US 6,432,547) in view of Noda et al. (US 6,808,795) and further in view of Wu (US 5,851,937). Applicants have amended claim 21 to recite a personal care product comprising a biodegradable film, wherein the biodegradable film comprises (among others) a water soluble polymer, wherein the water soluble polymer is polyethylene oxide, polyethylene glycol, or a copolymer thereof. Newly amended claim 21 is identical to claim 21 of Applicants' After-Final response, mailed December 13, 2005, which was not entered. Claims 2-14 and 17-20 have now been amended to depend from newly amended claim 21. Cancellation of claims 1 and 7 renders as moot the rejection against these claims.

Applicants continue to traverse the rejection in view of the fact that the Noda teachings relied upon by the Examiner are not disclosed in its priority application corresponding to US 6,808,795 (i.e. U.S. Provisional application No. 60/278,948, filed March 27, 2001). The Advisory Action, mailed January 11, 2006 argued that Applicants' arguments were unpersuasive. In particular, the Examiner conceded that although Noda does not teach the percentage of stretching in Example 6, Noda qualifies as prior art, because the provisional application discusses stretching on page 49, including a product being stretched in a range of 200 – 1500%. Applicants contend, however, that Noda's teachings in the provisional application regarding stretching do not provide a motivation for combining Kroll and Noda. The earlier Office Actions did not rely on Noda's teaching in Example 6 merely because of Example 6 teaching stretching. Instead, the obviousness rejections were predicated on the argument that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to stretch the film of Kroll between 0 – 400 percent of its original length as suggested by

Noda *motivated by the desire to enhance water vapor transmission rate through the film*" (emphasis added). In contrast to Example 6 in Noda's nonprovisional application, the provisional application makes no connection between stretching and water vapor transmission rates. Accordingly, the Office has failed to provide a prima facie case of obviousness in view of its failure to provide a basis for combining Noda and Kroll.

Not only does Noda's provisional application fail to provide a motivation based on its failure to disclose a connection between stretching and water vapor transmission rates, Noda does not provide any other motivation for stretching either. Although Noda teaches that the disclosed polymer products may be in any physical form, which may include stretched fiber- or nonwoven products (p. 48, lines 25-27), and acknowledges that other properties may be affected by stretching (p. 49, lines 4-10), Noda and Kroll cannot be combined, because neither reference provides a motivation for stretching Kroll's film in the first place. In view of the above arguments, Applicants respectfully request withdrawal of the rejection over Kroll et al. (US 6,432,547) in view of Noda et al. (US 6,808,795) and further in view of Wu (US 5,851,937).

Claims 1-3, 5-6, 8-9, and 17-21 stand rejected as being unpatentable over Wu et al. (US 5,851,937). The present claims stand rejected at least in part in view of Wu's disclosure of a stretched film comprising polycaprolactone blended with polyvinyl alcohol. Newly amended claim 21 (and claims depending therefrom) is directed to a biodegradable film comprising (among others) a water soluble polymer, wherein the water soluble polymer is polyethylene oxide, polyethylene glycol, or a copolymer thereof. Since Wu does not disclose or suggest a film wherein the water soluble polymer is polyethylene oxide, polyethylene glycol, or a copolymer thereof, the claims are not obvious over Wu. This would be consistent with the Office not rejecting previous claim 7 (which is similar to new claim 21) over Wu et al. (US 5,851,937). Accordingly, withdrawal of the rejection over Wu et al. (US 5,851,937).

Claims 1-3, 5-6, 8-14, and 17-21 stand rejected as being unpatentable over Wu et al. (US 5,200,247) in view of Wu (US 5,851,937). The present claims stand rejected

at least in part due to the teachings in Wu et al. (US 5,200,247) and Wu (US 5,851,937) concerning a stretched film comprising polycaprolactone blended with polyvinyl alcohol. Newly amended claim 21 (and claims depending therefrom) is directed to a biodegradable film comprising (among others) a water soluble polymer, wherein the water soluble polymer is polyethylene oxide, polyethylene glycol, or a copolymer thereof. Since neither of Wu et al. (US 5,200,247) nor Wu (US 5,851,937) discloses or suggests a film wherein the water soluble polymer is polyethylene oxide, polyethylene glycol, or a copolymer thereof, the claims are not obvious over Wu. This would be consistent with the Office not rejecting previous claim 7 (which is similar to new claim 21) over Wu et al. (US 5,200,247) in view of Wu (US 5,851,937). Accordingly, Applicants respectfully request withdrawal of the rejection over Wu et al. (US 5,200,247) in view of Wu (US 5,851,937).

It is believed that this application is now in condition for allowance. Such action is respectfully requested. If for any reason the Examiner is unable to allow the application in the next Office Action, Applicant respectfully requests an interview with the undersigned agent to discuss any outstanding issues.

Respectfully submitted,



Peter Brunovskis
Registration No. 52,441
Agent for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200